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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,551	03/16/2001	Erik-Andreas Klohr	MO-624/WN-55	2562

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BAYER CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,551

Applicant(s)

KLOHR ET AL.

Examiner

Brian P Mruk

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-28-01</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 3-4 and 11-12 are objected to because of the following informalities:

In instant claims 3-4 and 11-12, the phrase "selected from" should be amended to recite ---selected from the group consisting of--- to represent a proper Markush listing. **See MPEP 2173.05(h).**

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregory, U.S. Patent No. 2,727,837.

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Gregory, U.S. Patent No. 2,727,837, discloses a process for improving the bonding strength in coated papers comprising coating the paper with an aqueous solution of a water-soluble cellulose derivative as the binder and a coating pigment (see col. 2, lines 23-34). It is further taught by Gregory that suitable cellulose derivatives include sulfoethyl cellulose ethers with a degree of substitution of 0.3-0.6 (see col. 3, lines 31-60), that suitable pigments include clay and titanium dioxide (see col. 4, lines 17-27), and that the binder is present in the aqueous formulation in an amount of 3-15% by weight (see col. 4, lines 28-33), per the requirements of the instant invention. Specifically, note Examples 54-73. Therefore, instant claims 1-5 and 7-14 are anticipated by Gregory, U.S. Patent No. 2,727,837.

5. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith, U.S. Patent No. 2,759,853.

Smith, U.S. Patent No. 2,759,853, discloses a process for coating paper with an aqueous solution of a water-soluble cellulose derivative as the binder and a coating pigment (see col. 2, lines 4-48). It is further taught by Smith that suitable cellulose derivatives include sulfoethyl cellulose ethers with a degree of substitution of 0.12-1.0 (see col. 2, lines 36-45), that suitable pigments include clay, calcium carbonate, and titanium dioxide (see col. 4, lines 61-73), and that the binder is present in the aqueous formulation in an amount of 3-15% by weight (see col. 4, line 74-col. 5, line 3), per the requirements of the instant invention. Specifically, note Examples 1-4. Therefore, instant claims 1-5 and 7-14 are anticipated by Smith, U.S. Patent No. 2,759,853.

6. Claims 1-4, 6-11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kniewske et al, U.S. Patent No. 5,278,304.

Kniewske et al, U.S. Patent No. 5,278,304, discloses an aqueous composition comprising a water-soluble sulfoethyl cellulose ether as a binder (see abstract). It is further taught by Kniewske et al that suitable sulfoethyl cellulose ethers include methyl or ethyl sulfoethyl cellulose ethers and hydroxypropyl sulfoethyl cellulose ethers that have a degree of substitution of 0.001-0.7 (see col. 2, lines 40-50, col. 10, Table 1, and col. 12, lines 14-27), per the requirements of the instant invention. Specifically, note Examples 1-10. Therefore, instant claims 1-4, 6-11, and 13-14 are anticipated by Kniewske et al, U.S. Patent No. 5,278,304.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

BPM

Brian Mruk
May 8, 2004

Brian P. Mruk
Brian P. Mruk
Primary Examiner
Tech Center 1700